

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Agarwal, et al.
Patent No. : 7,533,090
Issue Date : May 12, 2009
Serial No. : 10/812,417
Filed : March 30, 2004
Title : SYSTEM AND METHOD FOR RATING ELECTRONIC DOCUMENTS

Art Unit : 2167
Examiner : Michael Pham
Conf. No. : 1265

Commissioner for Patents
P.O. Box 1450
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APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Patentee hereby requests reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. Reconsideration of the final PTA calculation to increase total PTA from 410 to 603 days, is respectfully requested.

REMARKS

“A Delays” are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. “B Delays” are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. To the extent that the periods of delay overlap, the period of any term adjustment shall not exceed the actual number of days the issuance of the patent was delayed. 35 U.S.C. § 154(b)(2)(A). As outlined in Wyeth et al. v. Jon W. Dudas (580 F. Supp. 2d 138; 88 USPQ 2d 1538), the only way that these periods of time can “overlap” is if they occur on the same day. If an “A delay” occurs on one calendar day and a “B delay” occurs on another calendar day, they do not overlap and 35 U.S.C. § 154(b)(2)(A) does not limit the extension to one day. Id.

The PTA for the instant patent, as currently calculated and shown on the face of the patent, apparently relies on the premise that the application was delayed under 35 U.S.C. § 154(b)(1)(B) *before* the initial three-year period expired. The Wyeth v. Dudas court determined that this construction cannot be squared with the language of 35 U.S.C. § 154(b)(1)(B), which applies “if the issue of an original patent is delayed due to the

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failure of the United States Patent and Trademark Office to issue a patent within 3 years.”

“B delay” begins only after the PTO has failed to issue a patent within three years, not before.

Id.

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

“A Delay”

A first PTO action was due on or before May 30, 2005 (the date that is fourteen months after March 30, 2004, the date on which the application was filed). The PTO mailed the first non-final Office Action on October 2, 2006, thereby according a PTO Delay of 490 days. Patentee does not dispute the PTO’s calculation for this “A Delay” from May 31, 2005 (the day after the date that is fourteen months after the date on which the application was filed), to October 2, 2006. See 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1).

In view of the period of “A Delay” detailed above, the total “A Delay” for this patent should be calculated as 490 days.

“B Delay”

The period beginning on March 31, 2007 (the day after the date that is three years after March 30, 2004, the date on which the application was filed), and ending May 12, 2009 (the date the patent was issued), is 774 days in length.

“B Delay” may not include the number of days in the period beginning on the date on which a Request for Continued Examination was filed and ending on the date the patent was issued. In the present application, a Request for Continued Examination was filed on October 9, 2007, and the patent issued on May 12, 2009, resulting in a period of 581 days that must be excluded from the three year delay calculation. See 37 C.F.R. §§ 1.702(b)(1) and 1.703(b)(1).

In addition, “B Delay” may not include the number of days in the period beginning on the date on which a Notice of Appeal was filed and ending on the date of mailing of a Notice of Allowance. In the present application, no Notice of Appeal was filed.
See 37 C.F.R. §§ 1.702(b)(4) and 1.703(b)(4).

In view of the periods of "B Delay" detailed above, the total "B Delay" for this patent should be calculated as 193 days (i.e., 774 days minus 581 days). The PTO calculated 0 days of delay for issuance of a patent more than three years after filing. Patentee respectfully submits that the PTO's calculation of this "B Delay" is incorrect and that the correct PTO Delay for issuance beyond three years from filing is 193 days. See 37 C.F.R. §§ 1.702(b) and 1.703(b).

Overlap of "A Delay" and "B Delay"

As detailed above, "A Delay" accumulated during the following period:

May 31, 2005, to October 2, 2006.

As detailed above, "B Delay" accumulated during the following period:

March 31, 2007, to October 9, 2007.

As such, the periods of "A Delay" and "B Delay" do not overlap (i.e., occur on the same calendar day).

Applicant Delay

A reply to an Office Action was due on or before January 2, 2007 (the date that is three months after October 2, 2006, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on March 2, 2007, thereby accruing an Applicant Delay of 59 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from January 3, 2007 (the day after the date that is three months after the date on which the Office Action was mailed), to March 2, 2007. See 37 C.F.R. § 1.704(b).

A reply to an Office Action was due on or before September 18, 2007 (the date that is three months after June 18, 2007, the date on which the Office Action was mailed). Patentee filed a response to the Office Action on October 9, 2007, thereby accruing an Applicant Delay of 21 days. Patentee does not dispute the PTO's calculation for this Applicant Delay from September 19, 2007 (the day after the date that is three months after the date on which the Office Action was mailed), to October 9, 2007. See 37 C.F.R. § 1.704(b).

In view of the periods of Applicant Delay detailed above, the total Applicant Delay for this patent should be calculated as 80 days (i.e., the sum of 59 days, and 21 days).

Terminal Disclaimer

This patent is not subject to a terminal disclaimer.

Conclusion

In consideration of the events described above, Patentee believes the PTA calculation of 410 days is incorrect. As such, Patentee respectfully requests reconsideration of the PTA in the following manner:

- 1) Total PTO Delay should be calculated as 683 days (i.e., the sum of 490 days of "A Delay" and 193 days of "B Delay");
- 2) Total Applicant Delay should be calculated as 80 days (i.e., the sum of 59 days, and 21 days); and
- 3) Total PTA should be calculated as 603 days.

The fee of \$200 required under 37 C.F.R. § 1.18(e) is being submitted herewith. Please apply any other required charges or credits to Deposit Account No. 06-1050, referencing attorney docket number 16113-0641001.

Respectfully submitted,

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